

### Remarks

Claims 1-20 are pending in the application. Claims 6-16 were rejected and claims 1-5 and 17-20 were withdrawn in response to a restriction requirement. Reconsideration of the claims is respectfully requested. No new matter has been added.

#### Rejection Under 35 U.S.C. § 102

Claims 6-8, 15 and 16 were rejected under § 102(b) as being anticipated by U.S. Patent No. 5,593,258 issued to Matsumoto et al. (hereinafter "Matsumoto '258"). Applicants respectfully believe that a *prima facie* case has not been established for the following reasons.

Claim 6 recites a "tool holder assembly for a cutting tool having an end surface and a fluid passage." The tool holder assembly comprises a tool holder and a sealing portion. The tool holder includes "a conduit having a threaded interior section, an adjustment screw having a threaded body section adapted to engage the threaded interior section and a flange section having a larger diameter than the threaded body section, the threaded body and flange sections defining an internal fluid passage disposed coaxially with the conduit, and a counterbore disposed coaxially with the conduit and adapted to receive the cutting tool." The sealing portion is "configured to inhibit fluid leakage between the flange section and the end surface" of the cutting tool. Matsumoto '258 does not disclose a sealing portion as claimed. In the Office Action, the Examiner stated that the "area of reference number 16, 18, 19 or 32 of Figure 1" was a sealing portion. Contrary to the Examiner's arguments, nothing in the area of reference number 16, 18, 19 or 32 of Figure 1 is a sealing portion as claimed. Instead, these elements relate to preloading of elastic member 16 "to inhibit vibrations during high speed machining" (see column 2, lines 54-62). More specifically, washer 18 is provided "for preload adjustment" and snap ring 19 presses "tapered sleeve 17 against the elastic member 18, thereby compressing the elastic member 16 and giving a preload thereto" (see column 5, lines 17-23). Indeed, there is absolutely no disclosure that any of these components or anything in the area of reference number 16, 18, 19 or 32 inhibits fluid leakage, let alone fluid leakage between the flange section of an adjustment screw and the end surface of a cutting tool.

as recited in claim 6. Moreover, there is no disclosure of any fluid being provided in the area referenced by the Examiner. Since no fluid is provided in the referenced area, there cannot logically be any disclosure or need for a sealing portion that inhibits fluid leakage as recited in claim 6. For these reasons, a *prima facie* case has not been established and Applicants respectfully request that this rejection be withdrawn. Since claims 7, 8, 15 and 16 depend on claim 6, a *prima facie* case has not been established for the rejection of these claims for the same reasons.

Claims 6-8, 10 and 15 were rejected under § 102(b) as being anticipated by U.S. Patent No. 5,004,382 issued to Yoshino (hereinafter "Yoshino '382"). Applicants respectfully believe that a *prima facie* case has not been established for the following reasons.

Claim 6 recites a "tool holder assembly for a cutting tool having an end surface and a fluid passage." The tool holder assembly comprises a tool holder and a sealing portion. The tool holder includes "a conduit having a threaded interior section, an adjustment screw having a threaded body section adapted to engage the threaded interior section and a flange section having a larger diameter than the threaded body section, the threaded body and flange sections defining an internal fluid passage disposed coaxially with the conduit, and a counterbore disposed coaxially with the conduit and adapted to receive the cutting tool." The sealing portion is "configured to inhibit fluid leakage between the flange section and the end surface" of the cutting tool. Yoshino '382 does not disclose a sealing portion as claimed. In the Office Action, the Examiner referenced column 3, lines 22-24 for support. The cited passage is reproduced below:

Between a front shell 5 of the drill driving means 1 and the rotating shaft 4 there is defined a mist chamber 6 sealed airtightly by a seal bearing 7. (Column 3, lines 22-24)

Seal bearing 7 does not inhibit fluid leakage between a flange section of an adjustment screw and an end surface of a cutting tool as recited in claim 6. Instead, seal

bearing 7 extends between front shell 5 and drill holding portion 3 (see Figure 2). As such, seal bearing 7 does not inhibit fluid leakage between fitting portion 35 (called a flange section of an adjustment screw by the Examiner) and the end surface of a tool (which was not pointed to with particularity by the Examiner but is clearly not associated with seal bearing 7). Consequently, Applicants respectfully believe that a *prima facie* case has not been established. Since claims 7, 8, 10 and 15 depend on claim 6, a *prima facie* case has not been established for the rejection of these claims for the same reasons.

#### **Rejection Under 35 U.S.C. § 103**

Claims 8-14 were rejected under § 103(a) as being unpatentable over Matsumoto '258. Claims 8-14 depend on claim 6. Therefore, Applicants believe that a *prima facie* case has not been established for the rejection of these claims for the reasons previously discussed.

Even if a proper rejection could be made for the rejection of claim 6, Applicants respectfully believe that a *prima facie* case has still not been established for the rejection of any of these claims. Matsumoto '258 does not disclose or remotely suggest a sealing portion as discussed above. Therefore, Matsumoto '258 cannot possibly disclose or suggest any of the sealing portion features recited in claims 8-14. In addition, the Examiner has provided no reference that discloses or remotely suggests any of the elements of claims 8-14. Instead, the Examiner has engaged in impermissible hindsight analysis by looking to the present invention as the sole basis for any of the claimed features, such as the male and female sealing portions. Applicants invite the Examiner to provide references that disclose or suggest these features. As the rejection presently stands, Applicants respectfully believe that a *prima facie* case has not been established and request that the rejection of these claims be withdrawn.

Claims 8-14 were rejected under § 103(a) as being unpatentable over Yoshino '382. Claims 8-14 depend on claim 6. Therefore, Applicants believe that a *prima facie* case has not been established for the rejection of these claims for the reasons previously discussed.

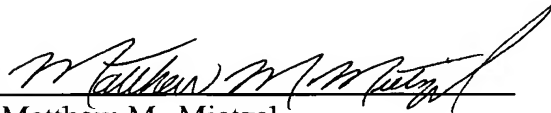
Even if a proper rejection could be made for the rejection of claim 6, Applicants respectfully believe that a *prima facie* case has still not been established for the rejection of any of these claims. Yoshino '382 does not disclose or remotely suggest a sealing portion as discussed above. Therefore, Yoshino '382 cannot possibly disclose or suggest any of the sealing portion features recited in claims 8-14. In addition, the Examiner has provided no reference that discloses or remotely suggests any of the elements of claims 8-14. Instead, the Examiner has engaged in impermissible hindsight analysis by looking to the present invention as the sole basis for any of the claimed features, such as the male and female sealing portions. Applicants invite the Examiner to provide references that disclose or suggest these features. As the rejection presently stands, Applicants respectfully believe that a *prima facie* case has not been established and request that the rejection of these claims be withdrawn.

#### **Conclusion**

Applicants have made a genuine effort to respond to the Examiner's objections and rejections in advancing the prosecution of this case. Applicants believe all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested.

Respectfully submitted,

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